

REMARKS

At the time of the Fourth Office Action dated October 27, 2009, claims 1-14 and 16 were pending and rejected in this application.

CLAIMS 1-4, 6, 10-14, AND 16 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON OWENS ET AL., U.S. PATENT NO. 6,633,630 (HEREINAFTER OWENS), IN VIEW OF NARASIMHAN ET AL., U.S. PATENT NO. 6,073,165 (HEREINAFTER NARASIMHAN), AND HURST ET AL., U.S. PATENT NO. 6,131,121 (HEREINAFTER HURST)

On pages 2-8 of the Fourth Office Action, the Examiner concluded that one having ordinary skill in the art would have considered the claimed invention to be obvious in view of Owens, Narasimhan, and Hurst. This rejection is respectfully traversed.

On October 10, 2007, the Patent Office issued the "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*," 72 Fed. Reg. 57,526 (2007) (hereinafter the Examination Guidelines). Section III is entitled "Rationales To Support Rejections Under 35 U.S.C. 103." Within this section is the following quote from the Supreme Court: "rejections on obviousness grounds cannot be sustained by merely conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Referring to the first column on page 57,529 of the Examination Guidelines for Determining Obviousness, the following is a list of rationales that may be used to support a finding of obviousness under 35 U.S.C. § 103:

(A) Combining prior art elements according to known methods to yield predictable results;

(B) Simple substitution of one known element for another to obtain predictable results;

(C) Use of known technique to improve similar devices (methods, or products) in the same way;

(D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

(E) "Obvious to try" - choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

(F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;

(G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Upon reviewing the Examiner's analysis on page 4 and 5 of the Fourth Office Action, the Examiner appears to be employing rationale (G). However, the Examiner's analysis is not entirely clear as to what rationale the Examiner is employing. Applicants, therefore, request that the Examiner clearly identify the rationale, as described in the Examination Guidelines for Determining Obviousness, being employed by the Examiner in rejecting the claims under 35 U.S.C. § 103.

Referring again to rationale (G), as discussed on page 57,534 of the Examination Guidelines for Determining Obviousness, the following findings of fact must be articulated by the Examiner:

(1) a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;

(2) a finding that there was reasonable expectation of success; and

(3) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

Referring to the paragraph entitled "Office Personnel as Factfinders" on page 57,527 of the Examination guidelines, the following was stated:

Office personnel fulfill the critical role of factfinder when resolving the *Graham* inquiries. It must be remembered that while the ultimate determination of obviousness is a legal conclusion, the underlying *Graham* inquiries are factual. When making an obviousness rejection, Office personnel must therefore ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied. In certain circumstances, it may also be important to include explicit findings as to how a person of ordinary skill would have understood prior art teachings, or what a person of ordinary skill would have known or could have done. Factual findings made by Office personnel are the necessary underpinnings to establish obviousness.

In *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), the Supreme Court set forth the factual inquiries that are to be applied when establishing a background for determining obviousness under 35 U.S.C. 103. These factual inquiries are summarized as follows:

(A) Determine the scope and content of the prior art;

(B) Ascertain the differences between the prior art and the claims at issue;

(C) Resolve the level of ordinary skill in the pertinent art; and

(D) Evaluate any indicia of nonobviousness.

However, in order to make a proper comparison between the claimed invention and the prior art, the language of the claims must first be properly construed. See In re Paulsen, 30 F.3d 1475, 1479 (Fed. Cir. 1994). See also, Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question, "what is the invention claimed?" since "[c]laim interpretation, ... will normally control the remainder of the decisional process.") See Gechter v. Davidson, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute).

Claim 1

On page 4 of the Fourth Office Action, the Examiner asserted the following with regard to the teachings of Owens and Narasimhan:

Owens did not expressly teach details regarding selecting a message filtering policy based on a communication characteristic of a link between brokering systems. IN analogous art (i.e. message communication in computer networks), Narasimhan discloses another message brokering system which discloses selecting a policy, based on the communication characteristic of the network (i.e. if server A is down, then go down the list of user defined available servers until an appropriate server is found which can route the message to the user) (col. 4, lines 30-63; col. 5, lines 25-30; col. 7, lines 1-15). (emphasis in original)

At the outset, Applicants note that the claimed language at issue is as follows:

a selection module, responsive to a communication characteristic of an inter-broker communication link effective to communicate messages between the message brokering system and one of said connected message brokering systems, configured to select a message filtering policy which is appropriate for the communication characteristic. (emphasis added)

The claimed "communication characteristic" is of "an inter-broker communication link effective to communicate messages between the message brokering system and one of said connected message brokering systems." This is entirely different than a communication characteristic of the network. Additionally, the claimed invention is directed to selecting a message filtering policy. Narasimhan does not "select" a policy based upon a particular communication characteristic. Instead, Narasimhan uses a message routing policy. A filtering policy describes what messages are to be sent (or not sent). Unlike a message filtering policy, a message routing policy describes where messages are to be sent.

Therefore, a proper characterization of the combination of Owens and Narasimhan would recognize that the combination fails to teach (i) a communication characteristic of *an inter-broker communication link effective to communicate messages between the message brokering system and one of said connected message brokering systems*; (ii) *selecting* a policy based upon this *particular type* of communication characteristic; and (iii) selecting a message *filtering* policy based this particular type of communication characteristic. The combination of Owens and Narasimhan teaches that in the event of a failure with a server/database, a message routing policy is used to route messages to an alternative server and/or mirrored database

Referring to page 5 of the Fourth Office Action, the Examiner made the following assertions with regard to the teachings of Hurst:

Hurst taught that a communication characteristic of an inter-broker communication link effective to communicate messages is used for selecting a message filtering policy (**abstract, column 4 lines 5-12, column 5 lines 57-63, column 7 lines 7-14, column 7 lines 24-26, column 7 lines 35-47 and column 8 lines 54-65**). In Hurst the characteristic in question is not whether a link is available, but a measure of redundant message transmissions over communication links that are, in fact, effective to communicate messages. (emphasis in original)

Again, the Examiner has mischaracterized the applied prior art based upon a misinterpretation of the phrase "message filtering policy." A discussion of the message sending logic 210 is found in Figure 3 and column 5, line 35 through column 6, line 9 of Hurst. Based upon a particular characteristic (see step 304 and Fig. 4), Hurst selects between sending the message using conventional techniques (i.e., step 310) or sending selected message using unicast (step 306) or multicast (step 308). In either instance, the message is sent, and thus, the message is not subject to filtering to control the forwarding of the messages via the inter-broker communication link. Thus, Hurst describes what could be considered a "message sending policy" (i.e., a policy describing how messages are to be sent). However, Hurst does not describe selecting a message filtering policy. Moreover, Hurst does not describe "selecting" since whatever policies being employed by Hurst are pre-set (i.e., static).

The Examiner's obviousness analysis is also found on page 5 of the Fourth Office Action and is reproduced below:

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to further modify the methods/systems of Owens combined with Narasimhan, with the teachings of Hurst. Owens motivated the exploration of the art of selecting filtering policies (**column 8 lines 29-31**). Hurst motivated the exploration of the art of selectively forwarding messages to recipients (**column 2 lines 54-57 and column 4 lines 5-12**). Hurst motivated the exploration of the art of multicasting and unicast in **column 1 lines 19-46**. The combination of Owens with Narasimhan would have been improved with the teachings of Hurst to avoid forwarding redundant messages to the receiving hosts (see Hurst **column 4 lines 5- 12**). (emphasis in original)

Again, the Examiner mischaracterized the applied prior art. Hurst is not related to "selectively forwarding messages to recipients," as alleged by the Examiner. Instead, Hurst is directed to choosing different mechanisms (i.e., unicast, multicast, or conventional) by which to send messages. Hurst does not select which messages are to be sent (or not sent). Instead, Hurst selects the technique by which the message is to be sent.

Although the combination of Owens and Narasimhan could conceivably be improved by the teachings of Hurst in order to avoid forwarding redundant messages, the combination of Owens, Narasimhan, and Hurst that achieves this benefit does not render obvious all of the claimed limitations since these benefits can be achieved without all of the claimed limitations.

For the reasons stated above, Applicant respectfully submits that the imposed rejection of claims 1-4, 6, 10-14, and 16 under 35 U.S.C. § 103 for obviousness based upon Owens in view of Narasimhan and Hurst is not viable. Hence, Applicants solicits withdrawal thereof.

CLAIM 5 IS REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON OWENS IN VIEW OF NARASIMHAN, HURST, AND KHAN ET AL., U.S. PATENT PUBLICATION NO. 2002/0143951 (HEREINAFTER KHAN)

On pages 8 and 9 of the Fourth Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Owens in view of Narasimhan, Hurst, and Khan to arrive at the claimed invention. This rejection is respectfully traversed.

Claim 5 depends from independent claim 1, and Applicant incorporates herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 103 for obviousness based upon Owens in view of Narasimhan and Hurst. The additional reference to Khan does not cure the argued deficiencies of Owens, Narasimhan, and Hurst. Accordingly, the proposed combination of references would not yield the claimed invention. Applicant, therefore, respectfully submit that the imposed rejection of claim 6 under 35 U.S.C. § 103 for obviousness

based upon Owens in view of Narasimhan, Hurst, and Khan is not viable and, hence, solicit withdrawal thereof.

CLAIMS 7 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON OWENS IN VIEW OF NARASIMHAN, HURST, AND DELANEY ET AL., U.S. PATENT PUBLICATION NO. 2001/0027479 (HEREINAFTER DELANEY)

On pages 9 and 10 of the Fourth Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Owens in view of Narasimhan, Hurst, and Delaney to arrive at the claimed invention. This rejection is respectfully traversed.

Claim 7 depends from independent claim 1, and Applicant incorporates herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 103 for obviousness based upon Owens in view of Narasimhan and Hurst. The additional reference to Delaney does not cure the argued deficiencies of Owens, Narasimhan, and Hurst. Accordingly, the proposed combination of references would not yield the claimed invention. Applicant, therefore, respectfully submit that the imposed rejection of claim 7 under 35 U.S.C. § 103 for obviousness based upon Owens in view of Narasimhan, Hurst, and Delaney is not viable and, hence, solicit withdrawal thereof.

**CLAIMS 8 AND 9 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON
OWENS IN VIEW OF NARASIMHAN, HURST, DELANEY AND KHAN**

On pages 10 and 11 of the Fourth Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Owens in view of Narasimhan, Hurst, Delaney, and Khan to arrive at the claimed invention. This rejection is respectfully traversed.

Claims 8 and 9 depend from independent claim 1, and Applicant incorporates herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 103 for obviousness based upon Owens in view of Narasimhan and Hurst. The additional references to Delaney and Khan do not cure the argued deficiencies of Owens, Narasimhan, and Hurst. Accordingly, the proposed combination of references would not yield the claimed invention. Applicant, therefore, respectfully submit that the imposed rejection of claims 8 and 9 under 35 U.S.C. § 103 for obviousness based upon Owens in view of Narasimhan, Hurst, Delaney, and Khan is not viable and, hence, solicit withdrawal thereof.

Applicant has made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicant invites the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicant hereby respectfully requests reconsideration and prompt allowance of the pending claims.

Although Applicant believes that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: January 26, 2010

Respectfully submitted,

/Scott D. Paul/
Scott D. Paul
Registration No. 42,984
Steven M. Greenberg
Registration No. 44,725
Phone: (561) 922-3845
CUSTOMER NUMBER 46320